

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY J. CAPONE,
RICHARD M. GARDNER,
MATTHEW M. MOHEBBI,
WALTER R. KEPLEY, III,
JOHN D. KENYON,
and
DAVID A. ROOS

Appeal No. 1999-1515
Application No. 08/451,719

HEARD: APRIL 25, 2001

Before JERRY SMITH, RUGGIERO, and LALL, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 18-27 and 30-44. Claims 1-17 have been canceled and claims 28 and 29 have been allowed.

The disclosed invention relates to a two-way mobile

telephony system in which a mobile terminal communicates with a fixed base station over a wireless link. More particularly, a method and apparatus is provided for establishing a seamless transfer or "hand-off" of communication with the mobile terminal to a further base station when communication quality deteriorates. As part of the "hand-off" technique, while a first two-way call is established between the mobile terminal and a base station, a second communication channel is used to search for another base station to establish a second two-way call with the mobile terminal. This second two-way call, established while the first two-way call exists, is a duplicate of the first call and is superimposed upon it. On detection of a degradation of the quality of the first call, the mobile terminal initiates a transfer of communication to the second communication channel by simultaneously switching the two-way signals from the first communication link to the second communication link.

Claim 18 is illustrative of the invention and reads as follows:

18. A method for providing communication between a mobile terminal and a plurality of unsynchronized base stations comprising the steps

Appeal No. 1999-1515
Application No. 08/451,719

of:

initiating the establishment of a first two-way call over a first communication link, said first two-way call carrying two-way signals between said mobile terminal and a first base station;

Appeal No. 1999-1515
Application No. 08/451,719

establishing a second communication link between
said mobile terminal and a second base station;

evaluating at least one characteristic of said
second communication link at said mobile terminal;

in response to said evaluating step, said mobile
terminal initiating the establishment of a second
two-way call, which is a duplicate of said first
two-way call, over said second communication link
while said first two-way call exists; and

performing a hand-off by simultaneously
switching said two-way signals from said first
communication link to said second communication link
under control of said mobile terminal.

The Examiner relies on the following prior art:

Goeken et al. (Goeken '766)	4,419,766	Dec. 06, 1983
Goeken (Goeken '303)	5,249,303	Sep. 28, 1993
		(filed Apr. 23, 1991)
Patsiokas et al. (Patsiokas)	5,392,331	Feb. 21, 1995
		(effectively filed Aug. 25, 1992)

Claims 18-27 and 30-44 stand finally rejected under
35 U.S.C. § 103 as being unpatentable over Goeken '766 in view
of Goeken '303 and Patsiokas.

Rather than reiterate the arguments of Appellants and the

Appeal No. 1999-1515
Application No. 08/451,719

Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 18-27 and 30-44. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is

¹ The Appeal Brief was filed April 3, 1998. In response to the Examiner's Answer dated June 9, 1998, a Reply Brief was filed Aug. 6, 1998, which was acknowledged and entered by the Examiner without further comment as indicated in the communication dated October 20, 1998.

Appeal No. 1999-1515
Application No. 08/451,719

incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837

F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1,

17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one

having ordinary skill in the pertinent art would have been led to

modify the prior art or to combine prior art references to arrive

at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole

or knowledge generally available to one having ordinary skill in

the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825

Appeal No. 1999-1515
Application No. 08/451,719

(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.,
776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

We consider first the Examiner's obviousness rejection of independent claims 18, 24, 33, and 39, all of which include the claimed feature of establishing a duplicate two-way call to effect a seamless transfer of communication between base stations. Appellants assert (Brief, page 8) that the Examiner has failed to establish a prima facie case of obviousness since none of the applied references suggest any reason why they might be combined.

After careful review of the applied prior art in light of

Appeal No. 1999-1515
Application No. 08/451,719

the arguments of record, we are in agreement with Appellants' position as stated in the Briefs. Our interpretation of the Goeken '766 reference coincides with that of Appellants', i.e., there is no transfer or "hand-off" of communication from one base station to another. Contrary to the Examiner's assertion, Goeken '766 selects a base station, from among a plurality of base stations, which will provide the best service over a predetermined maximum length telephone conversation, thereby permitting completion of a call with a single base station without "hand-off" (Goeken '766, column 9, lines 9-19).

Given this disclosure of Goeken '766, it is unclear as to how and what manner this reference would be modified to arrive at the claimed invention. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). None of the problems sought to be overcome by the applied secondary references to Goeken '303 or Patsiokas would be expected to exist in Goeken '766. Each of these references

Appeal No. 1999-1515
Application No. 08/451,719

have disclosures directed to the seamless transfer of communication between base stations, either in the one-way call system of Goeken '303, or the two-way call system of Patsiokas. Goeken '766, on the other hand, is not concerned with communication transfer between base stations, but rather with completing a high-quality call with a single base station without "hand-off."

In view of the above, we are left to speculate why the skilled artisan would employ any of the features of the communication "hand-off" features of Goeken '303 or Patsiokas in the system of Goeken '766. The only reason we can discern is improper hindsight reconstruction of Appellants' claimed invention. In order for us to sustain the Examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000 (1968). Therefore, since the Examiner has not established a prima facie case of obviousness, the rejection of independent claims 18, 24, 33, and 39, as well as claims

Appeal No. 1999-1515
Application No. 08/451,719

19-23, 25-27, 34-38, and 40-44 dependent thereon, over the combination of Goeken '766, Goeken '303, and Patsiokas is not sustained.

Appeal No. 1999-1515
Application No. 08/451,719

Turning to a consideration of independent claim 30, and its dependent claims 31 and 32, directed to the feature of preventing establishment of a communication link over at least one channel on determination of departure of a mobile terminal from a "steady state" zone, we do not sustain the Examiner's obviousness rejection of these claims as well. We agree with Appellants (Brief, page 9) that this aspect of this invention, which reserves at least one channel so that it can be used for possible call "hand-off," is not taught or suggested by any of the applied prior art references.

Appeal No. 1999-1515
Application No. 08/451,719

In conclusion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of all of the appealed claims cannot be sustained. Therefore, the decision of the Examiner rejecting claims 18-27 and 30-44 is reversed.

REVERSED

JERRY SMITH)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
PARSHOTAM S. LALL)	
Administrative Patent Judge)	

JFR:hh

Appeal No. 1999-1515
Application No. 08/451,719

SAMUEL H. DWORETSKY, ESQ.
AT&T CORP.
P.O. Box 4110
Middletown, NJ 07748-4110